

### REMARKS

In response to the Final Office action of August 20, 2007, applicants ask that all claims be allowed in view of the following remarks. Claims 1-20 are pending with claims 1, 19, and 20 being independent.

#### **Request for Withdrawal of Finality**

The MPEP provides that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c) with the fee set forth in 37 C.F.R. 1.17(p)." MPEP § 706.07(a). The final Office Action of August 20, 2007 includes new grounds of rejection that were neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. 1.97(c) with the fee set forth in 37 C.F.R. 1.17(p). Therefore, applicants respectfully request withdrawal of the finality and reopening of substantive prosecution on the merits for this case.

To explain, as originally filed, independent claim 1 recited, among other features, passively recognizing a set of contacts that are, as a group, repeatedly sent communications by a member. The non-final Office Action of March 23, 2007 rejected independent claim 1, contending that U.S. Patent No. 6,247,043 (Bates) disclosed this feature of independent claim 1 at col. 18, lines 55-66. On July 3, 2007, in response to the non-final Office Action of March 23, 2007, applicants filed an Amendment in Reply to Action of March 23, 2007, in which applicants made a formal, non-substantive amendment to this feature of independent claim 1 such that this feature of claim 1 presently recites passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member. See July 3, 2007 Amendment in Reply to Action of March 23, 2007 at page 7, line 20 to page 9, line 10. For reference, the amendments made to the original claim language are shown below, with added claim language being shown by underlining and deleted claim language being shown by strikethrough:

passively recognizing that a set of contacts [[that]] are, as a group,  
repeatedly sent communications by a member;

In the remarks provided with the July 3, 2007 Amendment in Reply to Action of March 23, 2007, applicants pointed out that the March 23, 2007 non-final Office Action failed to establish a basis within Bates for meeting this feature and, thus, requested reconsideration. Specifically, the remarks explained why col. 18, lines 55-66 of Bates, which were cited in the non-final Office Action of March 23, 2007, failed to meet this limitation. The final Office Action no longer references col. 18 of Bates, instead now citing a new and entirely different portion of the reference (i.e., col. 15, lines 42-57) in support of the current rejection. It therefore is clear that the failure of the previous rejection to meet this limitation, not applicants' amendment to this portion of claim 1 or other amendments to claim 1, necessitated the current rejection.

For at least the foregoing reasons, applicants submit that the finality of the final Office Action is improper. Accordingly, applicants respectfully request reopening of substantive prosecution on the merits.

### **Incomplete Office Action**

The Office Action indicates that dependent claims 5 and 6 have been rejected under 35 U.S.C. § 102 as being anticipated by Bates. See final Office Action of August 20, 2007 at page 2, lines 4. However, the Office Action does not clearly articulate grounds of rejection for dependent claims 5 and 6. As an initial matter, the Office Action does not appear to include any grounds of rejection for dependent claim 6. Rather, the Office Action appears to address dependent claim 5, skip dependent claim 6, and then address dependent claim 7. See Office Action of August 20, 2007 at page 4, lines 8-15. However, the grounds of rejection proffered for dependent claim 5 do not appear to correspond to the features recited in dependent claim 5. Rather, the grounds of rejection proffered for dependent claim 5 seem to correspond more closely to the features recited in dependent claim 6. See final Office Action of August 20, 2007 at page 4, lines 8-9. For example, dependent claim 6 recites the method of claim 1 further comprising enabling the member to assign a unique identifier to the contacts list, and the grounds of rejection proffered for dependent claim 5 state "[f]or claim 5, Bates teaches, the method of

claim 4 further comprising enabling the member to assign a unique identifier to the [sic] contacts list.”

Because the Office Action does not clearly articulate grounds of rejection for dependent claims 5 and 6, applicants are left without an understanding as to how the features recited in dependent claims 5 and 6 are believed to be met by Bates and, therefore, can not appropriately respond to the rejection of these claims. Consequently, applicants request that prosecution on the merits be reopened and that a new Office Action be issued that clearly articulates the grounds of rejection for dependent claims 5 and 6, so that applicants have “a fair opportunity to reply” to the rejection.

### **Claim Rejections**

The Office Action indicates that claims 1-20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Bates. See final Office Action of August 20, 2007 at page 2, lines 14-15. However, applicants note that the Office Action also indicates that claims 10 and 11 have been rejected under 35 U.S.C. § 103(a) as being obvious over Bates in view of U.S. Patent Application Publication No. 2004/0003071 (Mathew) and that the grounds of rejection proffered for claims 10, 11, 17, and 18 appear to rely on the combination of Bates and Mathew. See final Office Action of August 20, 2007 at page 8, lines 8-9; page 8, lines 10-19; page 5, lines 4-6; and page 9, line 1 to page 10, line 7. Therefore, applicants understand claims 1-9, 12-16, 19, and 20 as having been rejected under 35 U.S.C. § 102(b) as being anticipated by Bates, and claims 10, 11, 17, and 18 as having been rejected under 35 U.S.C. § 103(a) as being obvious over Bates in view of Mathew.

Independent claim 1 recites a method for enabling management of contacts that includes, among other features, passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, and generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member.

On page 2, lines 17-18, the Office Action indicates that Bates discloses passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member,

as recited in independent claim 1. Specifically, the Office Action identifies col. 15, lines 42-57 of Bates as disclosing this feature. Applicants disagree.

Specifically, Bates does not describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. Rather, Bates describes, at most, determining whether one individual user has exchanged more than a threshold number of communications with another individual user. In particular, as described by Bates:

[The automated addition of entries] is typically performed in response to an accumulation of contacts between a pair of users exceeding a predetermined threshold. . . .

Auto-add entry routine 152 is passed as input the user name being processed by update contact routine 142. . . .

Routine 152 begins in block 180 by determining whether the count field for the entry in the contact table corresponding to the user name passed to the routine exceeds a predetermined threshold. If it does not, no further processing is required, and the routine 152 terminates. If the count field is greater than the threshold, however, control passes to block 182 to determine whether or not the user name passed to the routine has an entry in the local contact database for the local user. If such an entry already exists, no further processing is required, and routine 152 terminates. However, if no such entry exists, control passes to block 184 to add an entry in the local contact database for the user by copying the corresponding entry from the master contact database. . . .

The predetermined threshold with which the count field for a user is compared may be set to any number of values to control the frequency at which new entries are added to the local database via routine 152. It will be appreciated that, the higher the threshold, the more contacts are required between any pair of users prior to addition of a new entry to the local contact database.

Bates at col. 15, lines 12-50 (emphasis added). As the passage excerpted above illustrates, Bates describes determining whether the number of communications exchanged between one individual user and another individual user exceeds a predetermined threshold, not whether an individual user has repeatedly sent communications to a set of contacts. As such, Bates fails to

describe or suggest passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member, as recited in independent claim 1. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 1 and its dependent claims, claims 2-18.

Independent claims 19 and 20 recite features that are similar to those discussed above in connection with independent claim 1, and do so in the context of an apparatus (claim 19) and a system (claim 20). Accordingly, applicants request reconsideration and withdrawal of the rejection of independent claims 19 and 20 at least for the reasons discussed above in connection with independent claim 1.

## **Conclusion**

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fees are believed due. Please apply any charges or credits to Deposit Account No. 06-1050.

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Respectfully submitted,

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